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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,358	11/26/2003	Heiko Glienicke	1020/013PUS1	6146
60601 7590 10/04/2007 MCGRATH, GEISSLER, OLDS & RICHARDSON, PLLC P.O. BOX 1364 FAIRFAX, VA 22038-1364			EXAMINER CHOI, JACOB Y	
			ART UNIT 2885	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,358	<b>Applicant(s)</b> GLIENICKE ET AL.	
	<b>Examiner</b> Jacob Y. Choi	<b>Art Unit</b> 2885	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Response to Amendment***

1. Examiner acknowledges that the applicant has newly added claims 20 and 21. Currently claims 1-21 are pending in the application.

### ***Specification***

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

3. Claims **1, 11, 15, and 16** are objected to because of the following informalities: It has been held that the recitation that an element is "*adapted to*", "*design to*", and "*able to*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Appropriate correction is required.

**Note:** The method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight (e.g., "... *the light rotor are formed*" & "... *light corona is formed*").

### ***Election/Restrictions***

4. Newly submitted claims 20-21 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: because of a

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different field of search (e.g., class/subclass) where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-21 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

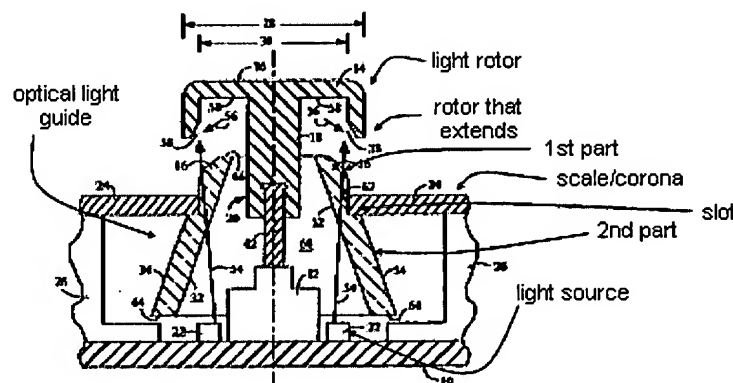
**Note:** Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972).

In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

6. Claims **1, 4-9, and 17** are rejected under 35 U.S.C. 102(e) as being anticipated by Zysnarski et al. (USPN 6,590,174).

Regarding claim 1, Zysnarski et al. discloses a combined scale and corona illumination (e.g., Figure 1), wherein the scale is a part of a panel (e.g., 24) that is *designed to work together with the control element (e.g., 14), an optical light guide (e.g., 16; column 3, lines 1-20) formed from a single piece that includes two parts (e.g., "upper portion & lower portion"; Figure 1), the two parts being partially separated by an annular slot (e.g., 68), such that parts of the panel engage or project into the slot, a light rotor (e.g., column 5, lines 5-7; "... interior surface 58 of the knob 14 may reflect light") that extends (e.g., 14) towards the optical light guide (e.g., 16) to a height necessary for light transport (e.g., column 5, lines 5-7; "... interior surface 58 of the knob 14 may reflect light, which ends up being transmitted through the gap 58") and a light source (e.g., 22) located below the light rotor (e.g., 14).*



Regarding claim 4, Zysnarski et al. discloses the corona is illuminated in the night design as a luminous ring around the rotary knob and is not illuminated in the daylight design and thus very difficult or impossible to detect (e.g., Figure 5; column 6, lines 40-60).

Regarding claim 5, Zysnarski et al. discloses the brightness of the scale is corona is regulated by light scattering wall thickness in the symbol area (e.g., column 5, lines 1-35).

Regarding claim 6, Zysnarski et al. discloses the brightness of the scale and corona is regulated by an appropriate wall thickness in the symbol area (e.g., column 5, lines 1-35).

Regarding claim 7, Zysnarski et al. discloses the brightness of the scale and corona is regulated by at least one light-diverting bevel on an underside of the optical light guide on a circumferential side (e.g., Figures 1 & 4)

Regarding claim 8, Zysnarski et al. discloses the optical light guide is fixed relative to the control element (e.g., Figure 1).

Regarding claim 9, Zysnarski et al. discloses the optical light guide is adjusted in functional combination with the light rotor (e.g., 14).

Regarding claim 17, Zysnarski et al. discloses the light guide provides light to illuminate the corona (e.g., Figures 4 & 5).

### ***Claim Rejections - 35 USC § 103***

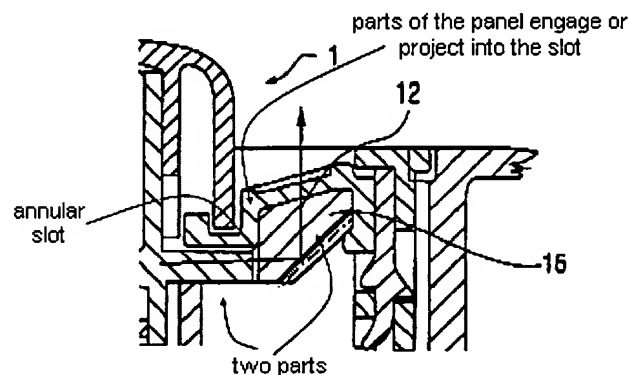
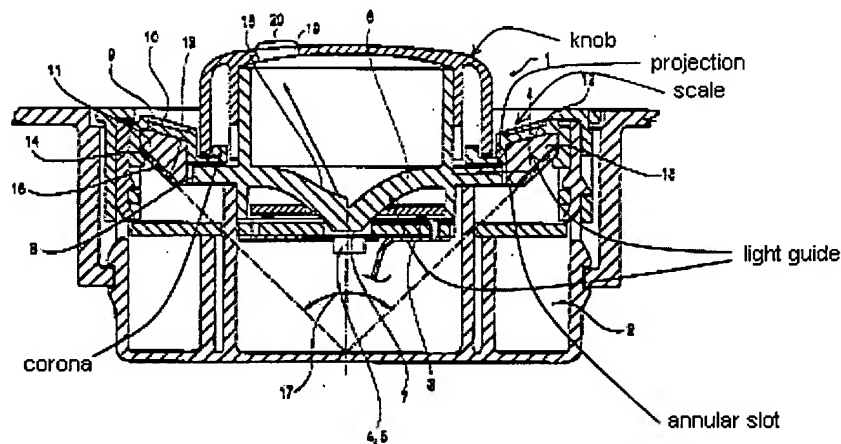
7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1, 2 and 4-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glienicke (USPN 6,224,221).

Regarding claim 1, Glienicke discloses a combined scale and corona illumination, wherein the scale is a part of a panel that is designed to work together with the control element, an optical light guide (e.g., 6, 11) that includes two parts (e.g., 6 & 11), which are partially separated by an annular slot (e.g., Figure 1), such that parts of the panel engage (e.g., 9) or project into the slot, a light rotor (e.g., 1, 19, and 20) that extends towards the optical light guide (e.g., 6, 11) to a height necessary for light transport, and a light source (e.g., 5) located below the light rotor (e.g., 1, 19, and 20).



Glienicke failed to specify that the first and second optical light guide formed forma single piece.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the first and second light-transmitting body to be a single piece. The following modification would have minimized number of working parts within the device. Also, the modification would further improve scale illumination (e.g., scale/corona) by minimizing the light lost, during light-rays transmitting from first to second body. It has been held that forming in one piece an article, which has formerly been formed in two pieces, and put together, involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Regarding claim 2, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses on the scale around the rotary knob of the control element are symbols.

Regarding claim 4, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the corona may be illuminated as a luminous ring around the rotary knob as radios, air conditioning units, and the like in motor vehicles being operated.

Regarding claim 5, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the brightness of the scale and corona is regulated by light-scattering components (e.g., diffuser) in the optical light guide (e.g., 6, 11).



Regarding claim 6, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the brightness of the scale and corona is regulated by an appropriate wall thickness in the symbol area (e.g., Figure 1).

Regarding claim 7, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the brightness of the scale and corona is regulated by at least one light-diverting bevel provided on an underside of the optical light guide on a circumferential side (e.g., Figures 3-4).

Regarding claim 8, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the optical light guide is fixed relative to the control element (e.g., Figure 1).

Regarding claim 9, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the optical light guide is adjusted in functional combination with the light rotor (e.g., 1).

Regarding claim 10, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the optical light guide and the light rotor are formed as a single piece (e.g., Figure 1).

Regarding claim 11, Glienicke a rotary knob (e.g., 1), a corona (e.g., 9) substantially circumscribing the rotary knob (e.g., 1), the corona being adapted to emit light therefrom, a scale (e.g., 10) substantially circumscribing the corona and the rotary knob (e.g., 1), the scale (e.g., 10) being adapted to emit light therefrom, an optical light guide (e.g., 6, 11) having an annular slot (e.g., Figure 1) provided therein, the annular slot being formed to receive a projection extending (e.g., 9) from the scale, the optical

light guide (e.g., 6, 11) directing light towards the scale and the corona, and a light rotor (e.g., 1) that directs light from a light (e.g., 5) source towards the optical light guide (e.g., 6, 11).

Glienicke failed to specify that the first and second optical light guide formed forma single piece.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the first and second light-transmitting body to be a single piece. The following modification would have minimized number of working parts within the device. Also, the modification would further improve scale illumination (e.g., scale/corona) by minimizing the light lost, during light-rays transmitting from first to second body. It has been held that forming in one piece an article, which has formerly been formed in two pieces, and put together, involves only routine skill in the art.

*Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Regarding claim 12, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the scale completely circumscribes the corona and the corona completely circumscribes the rotary knob (e.g., 1).

Regarding claim 13, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the light rotor directs light towards the optical light guide from an outer perimeter of the light rotor (e.g., 1).

Regarding claim 14, Glienicke discloses the scale includes at least one symbol formed thereon (e.g., column 3, lines 1-14).

Regarding claim 15, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses a surface of the corona is formed to resemble a surface of the rotary knob such that a user is not able to detect the corona when light is not being emitted by the corona (when the light source is turned on/off).

Regarding claim 16, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses a surface of the corona is formed to resemble a surface of the scale such that a user is not able to detect the corona when light is not being emitted by corona (e.g., Abstract; *"as radios, air conditioning units, and the like in motor vehicles being operated"*).

Regarding claim 17, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the light guide provides light to illuminate the corona (e.g., Figure 1).

Regarding claim 18, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses light from the light source illuminates the scale and the corona via the optical light guide and the light rotor (e.g., 10, 20).

Regarding claim 19, Glienicke discloses the claimed invention, explained above. In addition, Glienicke discloses the optical light guide provides light to both the scale and the corona (e.g., 10, 20).

9. Claims 2, 3 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zysnarski et al. (USPN 6,590,174).

Regarding claim 2, Zysnarski et al. discloses the claimed invention except for the details of the control elements being symbols.

However, Zysnarski et al. admits in "*Background*" invention that a knob has a transparent or translucent region that represents a symbol or a graphical form to provide a recognizable indicator of the knob during conditions of low ambient light (e.g., column 1, lines 10-30 & column 4, lines 15-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize symbols or graphical around the knob to provide recognizable indicator for the knob (e.g., Figure 5 & Figure 3; S16) to provide visual effect during low ambient light. The modification is desirable as suggested by Zysnarski et al.

Regarding claim 3, Zysnarski et al. discloses the claimed invention, explained above. In addition, Zysnarski et al. teaches that the symbols are produced by a laser, injection-molding, or film technique (e.g., column 1, lines 10-30).

Regarding claim 10, Zysnarski et al. discloses the optical light guide and the light rotor are formed as two-portions.

Zysnarski et al. failed to disclose the optical light guide and the light rotor is formed as a single piece. However, suggest that the knob and the light diffuser may appear to be one piece to a user (e.g., column 3, lines 50-55).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make both of the light guide (optical light guide & light rotor) into

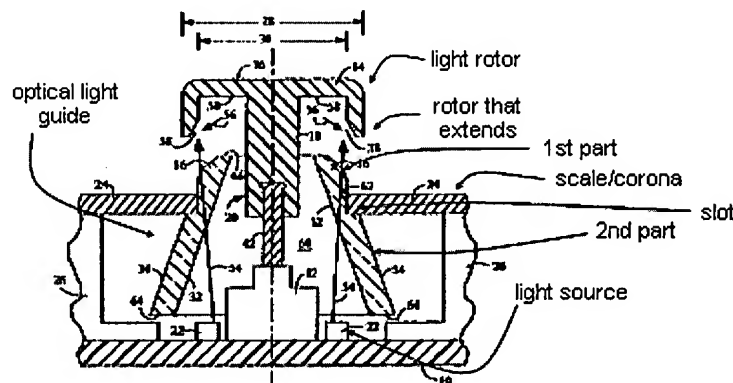
a single piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). The modification is desirable as suggested by Zysnarski et al.

### ***Response to Arguments***

10. Applicant's arguments filed July 16, 2007 have been fully considered but they are not persuasive.

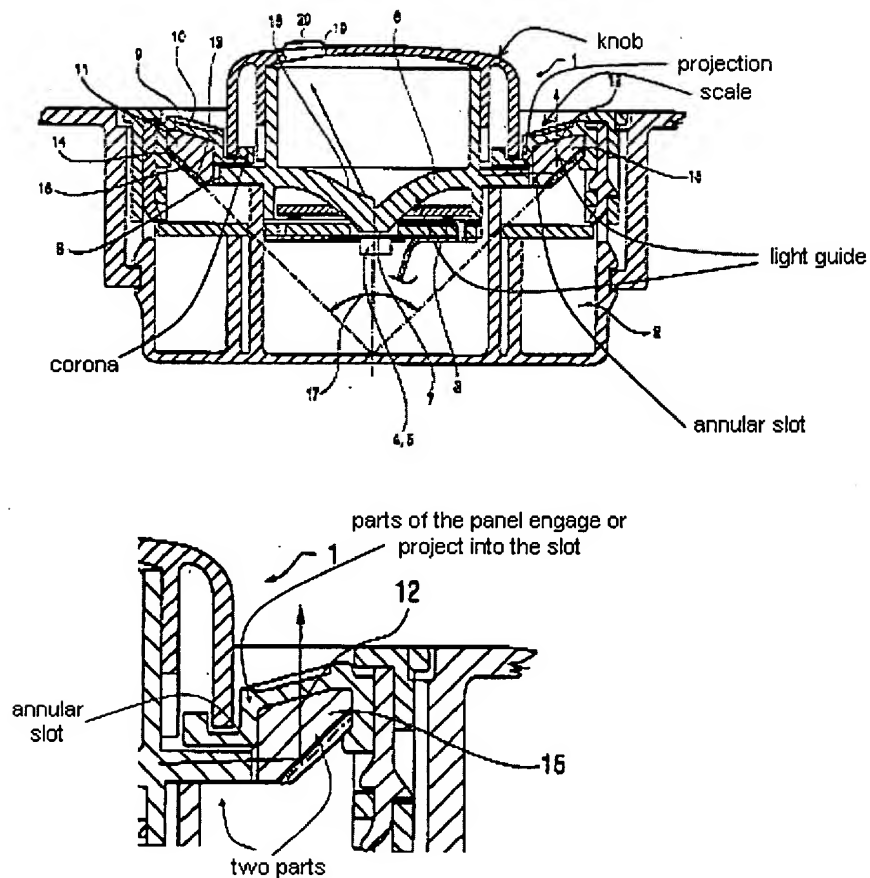
a) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "... *a light rotor that extends towards the optical light guide is a height necessary for light transport, and a light source located below the light rotor*") are clearly disclosed/shown by the cited prior art, Zysnarski et al. (USPN 6,590,174). The Examiner has carefully determined the scope of a claim by thoroughly analyzing the language of the claim. However, the result claims do not clearly overcome the cited prior art rejections. To clarify, applicant is reminded that claims in a pending application are given their broadest reasonable interpretation, including the phrase "*a light rotor*". *In re Pearson*, 181 USPQ 641 (CCPA1974). Zysnarski et al. states in column 5, lines 5-7; "... interior surface 58 of the knob 14 may reflect light"), where the Examiner reasonably interpreted the rotor of Zysnarski et al. is "*a light rotor*", because the rotor has an association with reflection of light. In addition, the language following the phrase "*a light rotor*" is considered to be a functional language. Applicant is again reminded that, in

order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279. Zysnarski et al. clearly shows the rotor that extends toward (e.g., see Figure below) the optical light guide for light transport (e.g., column 5, lines 5-7; "... *interior surface 58 of the knob 14 may reflect light, which ends up being transmitted through the gap 58*"). Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, claims are properly rejected under 35 USC § 102 and 103, as explained above.



b) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "... *the light from the light source 9 located below the light rotor 7 is transported through the light rotor 7 into the upper region, where it is coupled to the optical light guide 6 for backlighting*") are not recited in the rejected claim(s). However, recited claims are clearly disclosed/shown by the cited prior art, Glienicke (USPN 6,224,221).

Again, the Examiner has carefully determined the scope of a claim by thoroughly analyzing the language of the claim. However, the result claims do not clearly overcome the cited prior art rejections. To further clarify, the phrase "*a light rotor*" is clearly disclosed by the cited reference, see column 2, lines 60-65; "... *the light-transmitting body 6 of the rotatably knob 1 may possess a light emergence direction (arrow) which acts to illuminate a translucent area 19 with a pointer projection 20 in the rotatable knob1*". In addition, Glienicke clearly shows (e.g., see Figure below) "*a light rotor that extends toward the optical guide*" and "*the two parts being partially separated by an annular slot, such that parts of the panel engage or project into the slot*". Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972). In response to applicant's argument regarding functional recitation, in order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, claims are properly rejected under 35 USC § 102 and 103, as explained above.



### **Conclusion**

11 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



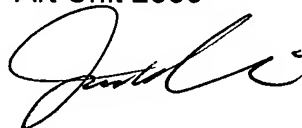
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jacob Y Choi  
Examiner  
Art Unit 2885



JC